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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,419	01/21/2004	Kuo-Tseng Lin	MR1035-1367	1220
4586	7590	08/10/2004	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			DANG, HUNG XUAN	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,419

Applicant(s)

LIN, KUO-TSENG

Examiner

Hung X Dang

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 10-12, 16 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 4-6, 8, 9, 13-15, 17-19 and 24-28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Information Disclosure Statement

1. If applicant is aware of any relevant prior art, he/she requested to cite it on form **PTO-1449** in accordance with the guidelines set forth in M.P.E.P. 609.

Claims Rejection Under 35 USC - 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10-12 and 20-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Whiting** (3,829,201).

Whiting discloses cushioning mount for a lens in the rim of an ophthalmic mounting which comprises a soft pad (20) including a fixing member (21) to wrap the edge of an upper portion of the eyeglass, said fixing member (21) being forwarded the inner side of the eyeglass (12) extending down to form a lining pad (24') of long shape to cover the inner surface of the upper portion of said eyeglass, and said fixing member (21) being forwarded the outer side of the eyeglass extending down to form a decorative member (24') of long shape to cover the outer surface of the upper portion of said eyeglass; and at least one fixing frame (10) having an embedding trench (two side walls 17 and the bottom wall 16), said eyeglass (12) and said fixing member (21) of said soft pad being equipped in said embedding trench and assembled with said fixing frame.

Claims Rejection Under 35 USC - 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 16, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Whiting** (3,829,201).

Whiting discloses cushioning mount for a lens in the rim of an ophthalmic mounting which comprises a soft pad (20) including a fixing member (21) to wrap the edge of an upper portion of the eyeglass, said fixing member (21) being forwarded the inner side of the eyeglass (12) extending down to form a lining pad (24') of long shape to cover the inner surface of the upper portion of said eyeglass, and said fixing member (21) being forwarded the outer side of the eyeglass extending down to form a decorative member (24') of long shape to cover the outer surface of the upper portion of said eyeglass; and at least one fixing frame (10) having an embedding trench (two side walls 17 and the bottom wall 16), said eyeglass (12) and said fixing member (21) of said soft pad being equipped in said embedding trench and assembled with said fixing frame.

Whiting does not teach the shape of the lining pad and the fixing member as that claimed by applicant.

Although the Whiting device does not teach the exact shape of the lining pad and the fixing member as that claimed by Applicant, the shape differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

Allowable Subject Matter

4. Claims 4, 5, 6, 8, 9, 13-15, 17-19 and 24-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

8/04



HUNG DANG

PRIMARY EXAMINER

TC 2800